

FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Hornback v. U.S., 04-5149 (Fed. Cir. Apr. 19, 2005) (Newman, J.)

The court affirmed the Court of Federal Claims dismissal of Hornback's "claim seeking compensation for the reclassification of his patent application as secret." There was no declassification and reclassification that might trigger a taking claim because only the PTO commissioner can rescind a secrecy order. The mere internal downgrading and later upgrading of the application by the Air Force does not qualify.

Hornback's patent application of 1986 issued in 2000 as U.S. Patent No. 6,079,666, for a "Real Time Boresight Error Slope Sensor." There was a secrecy order on the application from 1987 to 1999.

The appeal concerns two issues.

First, Hornback filed in the Court of Federal Claims, arguing that the government declassified and reclassified the patent application, constituting a taking of his property. In that same suit, he petitioned for a remand of the patent to the PTO for correction.

The court affirmed the Court of Federal Claim's determination that Hornback was barred by claim preclusion.

The Court of Federal Claims referred to Mr. Hornback's nine prior suits seeking declassification of the secrecy order or compensation therefor, five of which were dismissed with prejudice. . . .

Mr. Hornback argues that the present case is brought not on the initial secrecy order, but on the reclassification. As support, he points to three documents in the record.

The court rejected Hornback's approach because in an earlier opinion it had already opined that the documents did not describe a declassification and then a reclassification: "the internal action of the Air Force in downgrading his application to unclassified in 1994 did not lift the order 'because only the Commissioner of Patents may rescind a secrecy order.'" Thus, this aspect of his claim had already been adjudicated and claim preclusion was a proper

basis for the Court of Federal Claims to dismiss the action.

Second, Hornback sought to correct the issued patent, but took a circuitous and jurisdictionally incorrect approach. After petitioning the PTO to correct the patent, in 2001 Hornback filed a writ of mandamus at the Federal Circuit. The court denied the petition because Hornback should have started in the district court.

Given these setbacks, Hornback added a petition to his suit before the Court of Federal Claims to cause the PTO to correct the patent.

We agree that the Court of Federal Claims does not have subject matter jurisdiction of an adverse ruling of the PTO Director. 28 U.S.C. § 1361 vests "original jurisdiction" for the issuance of mandamus orders in the district courts, authorizing the district court to hear any action "to compel an officer or employee of the United States or any agency thereof to perform a duty owed to the plaintiff."



FindLaw

Find a
LawyerLegal
Forms &
ServicesLearn
About the
LawLegal
Professionals

Blogs

[FINDLAW](#) / [CASE LAW](#) / [UNITED STATES](#) / [US FED. CIR.](#) / HORNBACK V. UNITED STATES

HORNBACK v. UNITED STATES (2010)

United States Court of Appeals, Federal Circuit.

Alton B. HORNBACK, Plaintiff-Appellant, v. UNITED STATES, Defendant-Appellee.

No. 2009-1543.

Decided: April 15, 2010

Before MICHEL, Chief Judge, and RADER, Circuit Judges, and FOLSOM, District Judge.*

Alton B. Hornback, of San Diego, CA, pro se. Susan L.C. Mitchell, Attorney, Commercial Litigation Branch, Civil Division, U.S. Department of Justice, of Washington, DC, for defendant-appellee. Tony West, Assistant Attorney General, and John

Alton B. Hornback appeals an order from the United States District Court for the Central District of California dismissing his complaint for failure to state a claim under Federal Rule of Civil Procedure. Because the Invention Secrecy Act, 35 U.S.C. § 181, bars a cause of action for the government's use of an invention subject to a secrecy order and a patent on that invention, this court affirms.

I.

Mr. Hornback is the named inventor of U.S. Patent No. 6,079,666, entitled "Boresight Error Slope Sensor." The '666 patent resulted from a patent application filed on April 25, 1986. The Air Force subsequently classified Mr. Hornback's application as "secret" and accordingly, the United States Patent and Trademark Office ("PTO") imposed a secrecy order under U.S.C. § 181. On September 17, 1987, the PTO issued a "Notice of Allowability" that stated that

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat



application was "in condition for allowance" but that "in view of the secrecy order issued August 24, 1987, under 35 U.S.C. (1952) 181, this application will be withheld from issue during such period as the national interest requires." The government rescinded the secrecy order on April 21, 1999, and the '666 patent issued on June 27, 2000.

Mr. Hornback, who is pursuing his claim pro se, seeks compensation under 35 U.S.C. § 183 for the government's use of the invention. Initially, Mr. Hornback sought compensation for government use that occurred both before and after the issuance of the patent. The district court, however, held that res judicata barred Mr. Hornback's claims for any government use that occurred on or before July 5, 2000. Mr. Hornback does not challenge that ruling on appeal.

As a result of the district court's res judicata ruling, Mr. Hornback's claim for compensation was limited to government use that occurred after issuance of the '666 patent. Relying on that limitation, the government moved to dismiss the complaint for lack of subject matter jurisdiction, arguing that "pursuant to the express terms of [section 183], an applicant's right to compensation is limited to recovering for wrongful use occurring only during the time during [sic] which a secrecy order is pending" and therefore that "Hornback has no cause of action for unauthorized governmental use of his invention under 35 U.S.C. § 183 occurring after April 21, 1999."

The district court, construing the government's motion as one for failure to state a claim, granted the government's motion to dismiss. The district court held that under section 183 damages are recoverable for government use only during the pendency of a secrecy order.

Mr. Hornback timely appealed to this court, arguing that section 183 entitles him to compensation for government use that occurred after the '666 patent issued, not only during the pendency of the secrecy order but also after its termination pursuant to 28 U.S.C. § 1295(a)(1).

II.

A.

Because the district court dismissed this action pursuant to Fed. R. Civ. P. 12(b)(6), we review *de novo*. *Barker v. Riverside County Office of Educ.*, 584 F.3d 821, 824 (9th Cir. 2019); *Star Seismic LLC*, 566 F.3d 1069, 1072 (Fed.Cir.2009) ("The question properly granted is a purely procedural question not pertaining to the merits of the case under the rule of the regional circuit.") (quotation marks and alterations omitted). In *dismissing* an action pursuant to Rule 12(b)(6), "we accept as true the facts alleged in the complaint" and "must draw inferences in the light most favorable to the plaintiff." *Barker*, 584 F.3d at 824 (quotation marks omitted).

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat

B.

The Invention Secrecy Act entered the U.S. Code on July 19, 1952. 66 Stat. 805 (current version at 35 U.S.C. §§ 181-188). It authorizes government agencies to make a determination that the publication or disclosure of an invention described in an application for a patent "would be detrimental to the national security." 35 U.S.C. § 181. If a government agency makes such a determination, it "shall notify the Commissioner of Patents and the Commissioner of Patents shall order that the invention be kept secret and shall withhold publication of the application or the grant of a patent for such period as the national interest requires." *Id.* Once a secrecy order has issued, "[t]he Commissioner of Patents may rescind [the] order upon notification by the heads of the departments and the chief legal officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security." *Id.*

Section 183 authorizes an applicant whose invention was subject to a secrecy order to seek "compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure." That section describes two avenues an applicant may follow to obtain relief.

First, an applicant may apply for compensation directly from the head of the department or agency that sought imposition of the secrecy order. If the applicant is unhappy with the award that the government department or agency provides, the claimant may bring suit against the United States either in the United States Court of Federal Claims or in the District Court of the United States for the district in which the claimant is a resident "for an amount which when added to [the] amount awarded by [the] government department or agency] shall constitute just compensation for the use of the invention by the Government." If applicants choose this first avenue, "beginning at the date the applicant [receives the] secrecy order], his application is otherwise in condition for allowance of the patent if [the] patent is issued thereon."

Second, rather than apply first for compensation from a government department or agency, the Act also gives an applicant the right "to bring suit in the United States District Court for the district in which the applicant resides for compensation for the damage caused by reason of the order of secrecy and/or for the use of the invention resulting from his disclosure." *Id.* In order to file suit, the applicant must first apply to the government department or agency, however, the claimant may not sue until the issuance of [the] patent." *Id.*

This appeal provides this court with its first opportunity to squarely address whether the "use of the invention by the Government" language in section 183 includes use of the invention that occurred after the patent for the invention has issued. Although the district court declared that that phrase only covers

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat

use during the pendency of a secrecy order, the facts of this case demonstrate that there can be a time lag (here, over one year) from when the PTO rescinds a secrecy order and when the patent actually issues. Because Hornback does not dispute that res judicata bars his claim for compensation as to that time period, this court does not need to address whether section 183 might encompass use after a secrecy order is rescinded but before the patent issues.

The terms of section 183 are broadly stated: "use of the invention" is not explicitly limited to use before a patent for the invention has issued. In interpreting a statute, however, "we must not be guided by a single sentence or member of a sentence, but look to the provisions of the whole law, and to its object and policy." U.S. Nat'l Bank of Or. v. Indep. Ins. Agents of Am., Inc., 508 U.S. 439, 455, 113 S.Ct. 2173, 124 L.Ed.2d 402 (1993) (internal quotation marks omitted).

Looking to other relevant provisions of law, this court notes that 28 U.S.C. § 1498 is closely related. Section 1498(a) enables a patent owner to file suit against the government in the Court of Federal Claims for government use of a patented invention. That section states, "Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States . the owner's remedy shall be by action against the United States in the United States Court of Federal Claims for the recovery of his reasonable and entire compensation for such use and manufacture." (emphasis added). The language of section 1498(a) is mandatory, and therefore grants the Court of Federal Claims exclusive jurisdiction to hear all claims against the government arising out of post-issuance government use of an invention. Crater Corp. v. Lucent Techs., Inc., 255 F.3d 1361, 1364 (Fed.Cir.2001). That exclusive jurisdiction has been established since 1918. 40 Stat. 705 (1918). This court presumes that the later enactment of the Invention Secrecy Act took this important ex Marine Corp., 498 U.S. 19, 32, 111 S.Ct. 317, 112 L.Ed.2d 275 (1 Federal Claims' exclusive jurisdiction, the Invention Secrecy Act claims insofar as they allege post-issuance government use.

Section 183 is also closely related to 35 U.S.C. § 181. Section 181 is related to section 183's phrase "use of the invention . resulting The first is the applicant's disclosure of the invention in his patent disclosure by the Commissioner of Patents to officers of a government of disclosures concern non-public disclosures; in contrast, once publicly disclosed. Because section 181 concerns non-public disclosures, section 183 similarly provides a remedy only for use of an invention by the PTO.

Finally, returning to the section at issue, the six-year post-issuance deadline in section 183, which cuts off a patentee's right to apply to a department or agency for compensation, stands in contrast to the six-year statute of limitations for patent infringement damages generally, found in 35 U.S.C. § 286. If the

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat

Invention Secrecy Act had sought to make the department or agency route available for post-issuance use, it would not have arbitrarily cut off the right to apply for compensation for such use after only six years post-issuance, rather than simply adopting the six-year statute of limitations found in section 286. Instead, by cutting off the right to even apply for compensation at six years after the patent issues, it appears that the Invention Secrecy Act only addressed recovery for the limited period of pre-issuance use.

Mr. Hornback contends that the legislative history of the Invention Secrecy Act compels this court to construe section 183 in his favor. In particular, Mr. Hornback relies on the following exchange between Paul Rose, who was testifying on behalf of the American Patent Law Association, and Congressman Edwin Willis from Louisiana:

Mr. Rose. Now, as to use by the Government the Government has the right to the use of the invention upon the payment of compensation.

Mr. Willis. But it has that right today, without this act, as provided by the act of 1910.

Mr. Rose. No, but the difference between this act and the act of 1910 is that if the Government uses an invention which is placed under a secrecy order, then after the patent issues the inventor, the patentee, may collect for the use of it prior to the date of issuance of the patent. In other words, he may carry his claim back to the first date of use by the Government, whereas under the act of 1910 you only collect for damages after the issuing date of the patent.

Mr. Willis. In other words, this applies to a case for damages at

Mr. Rose. That is right.

Mr. Willis. And in this case it gives a cause of action to the patentee if the Government uses the invention without the patent?

Mr. Rose. Yes, sir; that is correct.

Patent Disclosure: Hearing Before Subcomm. No. 3 of the H. C. (1951) (emphasis added). This court finds the preceding passage assumes that the pronoun "this" in the emphasized portion of the passage could just as easily be a reference to the act of 1910, predecessor to section 1498. See 40 Stat. 705. Indeed, because of the difference between that earlier act and section 183, the legislative history on which Mr. Hornback relies appears to counsel against his interpretation rather than for it.

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat

In sum, this court holds that “use of the invention” in 35 U.S.C. § 183 does not include use of an invention after a patent for the invention has issued. This interpretation is consistent with the reading provided by this court's predecessor, which noted, in dicta, that “[s]ection 183 provides for damages to be paid to patent holders in two situations: when the Government wrongfully uses the patented device during the period of secrecy, and when the secrecy order itself causes damages.” *McDonnell Douglas Corp. v. United States*, 229 Ct.Cl. 323, 670 F.2d 156, 163 (1982) (emphasis added). Although this interpretation is inconsistent with that provided by *Farrand Optical Co. v. United States*, 197 F.Supp. 756, 758 (S.D.N.Y.1961), rev'd, 317 F.2d 875, 883 (2d Cir.1962), aff'd en banc by an equally divided court, 317 F.2d 875, 883 (2d Cir.1963), this court, for the reasons addressed above and to honor its predecessor court, declines to follow that case.

III.

For the foregoing reasons, the judgment of the United States District Court for the Southern District of California dismissing Mr. Hornback's case for failure to state a claim is affirmed.

AFFIRMED.

COSTS

Each party shall bear its own costs.

RADER, Circuit Judge.

Was this helpful?

Yes



No



ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat

Welcome to FindLaw's Cases & Codes

A free source of state and federal court opinions, state laws, and the United States Code. For more information about the legal concepts addressed by these cases and statutes visit FindLaw's Learn About the Law.

[Go To Learn About The Law >](#)

HORNBACK v. UNITED STATES (2010)

Docket No: No. 2009-1543.

Decided: April 15, 2010

Court: United States Court of Appeals,Federal Circuit.

Need to Find an Attorney?

Search our directory by legal issue

Enter information in one or both fields (Required)

Legal Issue

City, ZIP Code or County

Rawalpindi, Punjab

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



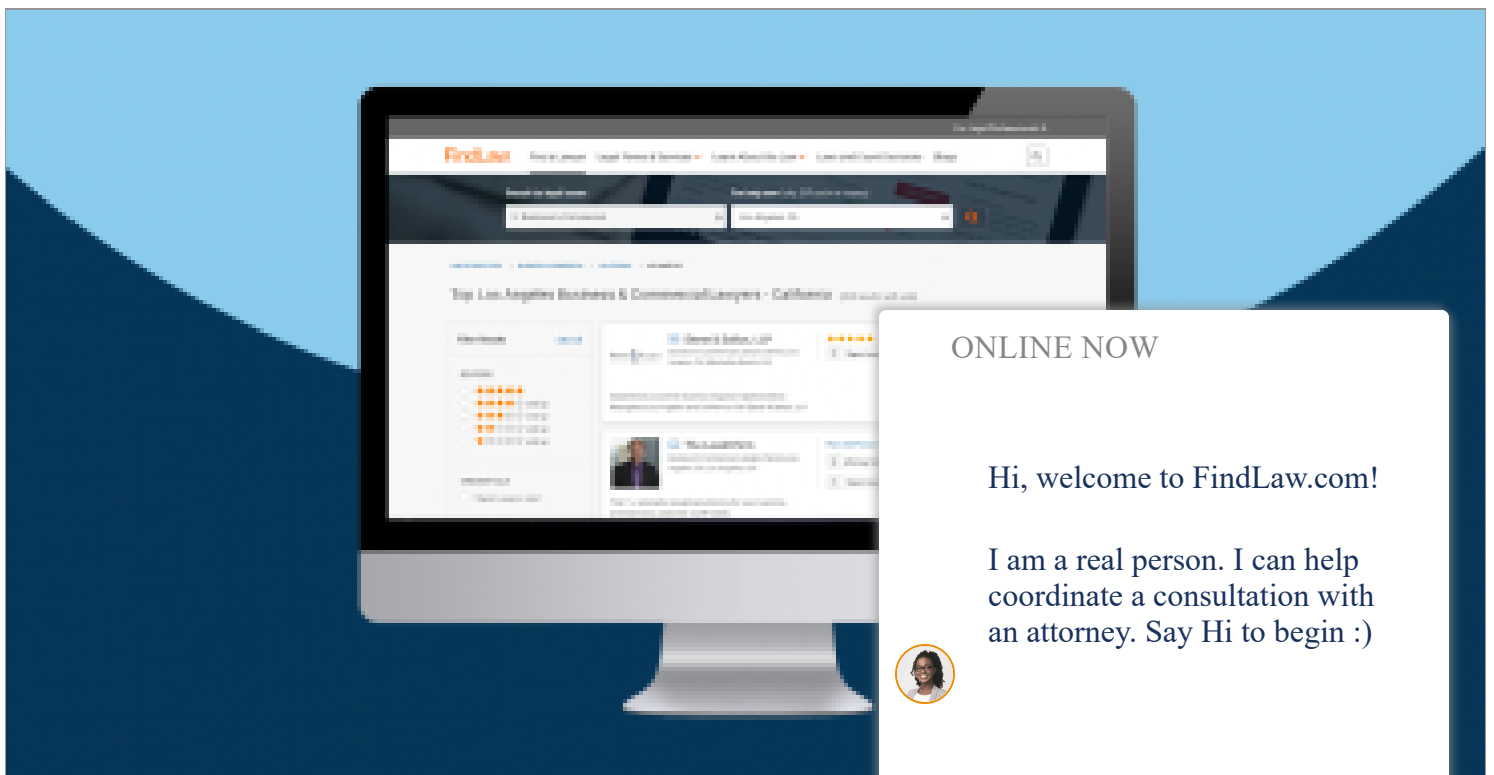
Start Chat



[Find a Lawyer >](#)

For Legal Professionals

- > [Practice Management](#)
- > [Legal Technology](#)
- > [Law Students](#)



ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



[Start Chat](#)

Get a profile on the #1 online legal directory

Harness the power of our directory with your own profile. Select the button below to sign up.

[Sign Up >](#)

Get updates from FindLaw Legal Professionals



Enter your email address to subscribe:

Email (Required)

>

[Learn more about FindLaw's newsletters](#), including our terms of use and privacy policy.

Learn About the

Get help with your legal

FindLaw's Learn About the Law features thousands of attorneys to help you understand your options. And if you're ready to hire an attorney, you can find one who can help.

[Go to Learn About The](#)

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



[Start Chat](#)



Need to Find an Attorney?

Search our directory by legal issue

Enter information in one or both fields (Required)

Legal Issue

City, ZIP Code or County

Rawalpindi, Punjab



ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat

[Find a lawyer >](#)

[↑ BACK TO TOP](#)

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help
coordinate a consultation with
an attorney. Say Hi to begin :)



[Start Chat](#)



Questions?

At FindLaw.com, we pride ourselves on being the number one source of free legal information and resources on the web. **Contact us.**

Stay up-to-date with how the law affects your life. Sign up for our consumer newsletter.

ENTER YOUR EMAIL ADDRESS (Required)



FOLLOW US:



Copyright © 2026, FindLaw. All rights reserved.

[Terms >](#) | [Privacy >](#) | [Disclaimer >](#) | [Cookies >](#) | [Manage Preferences](#)

ABOUT US >

[Our Team](#)

[Accessibility](#)

[Contact Us](#)

FIND A LAWYER >

[By Location](#)

[By Legal Issue](#)

[By Lawyer Profiles](#)

[By Name](#)

SELF-HELP RESOURCES

[Legal Forms & Services](#)

LEGAL RESEARCH

[Learn About the Law](#)

[State Laws](#)

[U.S. Caselaw](#)

[U.S. Codes](#)

ONLINE NOW

Hi, welcome to FindLaw.com!

I am a real person. I can help coordinate a consultation with an attorney. Say Hi to begin :)



Start Chat